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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,305	11/02/2001	Ji Ming Wang	NIH171.001C1	7901

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EXAMINER

KEMMERER, ELIZABETH

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,305

Applicant(s)

WANG ET AL.

Examiner

Elizabeth C. Kemmerer, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-5 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

-
- I. Claim 1 (in part), drawn to method of administering a T20/DP178 FPR antagonist, classification dependent upon structure of antagonist.
 - II. Claim 1 (in part), drawn to method of administering a T21/DP107 FPR antagonist, classification dependent upon structure of antagonist.
 - III. Claim 2 (in part), drawn to complex comprising T20/DP178 or generic variants thereof, classification dependent upon final structure of complex.
 - IV. Claim 2 (in part), drawn to complex comprising T21/DP107 or generic variants thereof, classification dependent upon final structure of complex.
 - V. Claims 3 and 4 (each in part), drawn to methods of administering T20/DP178 or generic variants thereof, classified in class 514, subclass 2.
 - VI. Claims 3 and 4 (each in part), drawn to methods of administering T21/DP107 or generic variants thereof, classified in class 514, subclass 2.
 - VII. Claim 5 (in part), drawn to method of making a pharmaceutical product comprising T20/DP178 or a generic variant thereof, classification dependent upon structure of recited agent.
-
- VIII. Claim 5 (in part), drawn to method of making a pharmaceutical product comprising T21/DP107 or a generic variant thereof, classification dependent upon structure of recited agent.
-

The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons. Groups III and IV are directed to products that are distinct both physically and functionally, are not required one for the other, and are therefore patentably distinct, since Group III requires T20/DP178 and Group IV requires T21/DP107. Each requires a separate search of the art.

Similarly, although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons: Groups I, II and V-VIII are directed to methods that are distinct both physically and functionally, and are not required one for the other. Invention I requires administration of a T20/DP178 FPR antagonist, which is not required by any of the other groups. Invention II requires administration of a T21/DP107 FPR antagonist, which is not required by any of the other groups. Invention V requires administration of T20/DP178, which is not required by any of the other groups. Invention VI requires administration of T21/DP107, which is not required by any of the other groups. Invention VII requires a screening assay involving T20/DP178, which is not required by any of the other groups. Invention VIII requires a screening assay involving T21/DP107, which is not required by any of the other groups. Therefore, a search and examination of all three methods in one patent application

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would result in an undue burden, since the searches for the three methods are not co-extensive, the classification is different, and the subject matter is divergent.

Inventions VII and III are related as process of making and product made.

Similarly, Inventions VIII and IV are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the products can be made without the screening steps recited in the claims, for example, by chemical synthesis.

The remaining pairs of Inventions (III/I; III/II; III/V; III/VI; III/VIII; IV/I; IV/II; IV/V; IV/VI; IV/VII) are unrelated since the methods do not require the products.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, separate search requirements and different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth C. Kemmerer, Ph.D. whose telephone number is (703) 308-2673. The examiner can normally be reached on Mon. - Thurs., 6:30 to 4:00, and alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne L. Eyler, Ph.D. can be reached on (703) 308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Elizabeth C. Kemmerer

ECK
March 18, 2003

ELIZABETH KEMMERER
PRIMARY EXAMINER